



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*Ch*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,233	04/02/98	RICE	A 17111-23US

020350 LMC1/0711  
TOWNSEND AND TOWNSEND AND CREW LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO CA 94111

EXAMINER

PENDER JR, M

ART UNIT

PAPER NUMBER

2762

*4*

DATE MAILED:

07/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/054,233

Applicant(s)  
Rice et al.

Examiner  
Michael Pender

Group Art Unit  
2762



☒ Responsive to communication(s) filed on Apr 2, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-66 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-66 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2762

### **DETAILED ACTION**

1. **Claims 1-66** have been examined and rejected.

#### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
3. Applicants are encouraged to submit a proper Information Disclosure Statement citing relevant prior art.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 54-57** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

Art Unit: 2762

art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Claim 54:**

*The method of claim 1, further comprising the steps of*

- *receiving the electronic message from the source in a first data format; and*
- *converting the electronic message from the first data format to an electronic message having a second data format.*

**Claim 54** is rejected because Applicant does not teach how to convert an electronic message from one data format to another. **Claims 55-57** are rejected as dependent on rejected claim 54.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-66** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention merely relates a computer program, consisting of an algorithm and a data structure. *See* MPEP § 2106 (IV)(B)(1). Applicants are reminded that statutory processes must be limited to a practical application, such as transforming “raw” goods into a finished product. Examiner concludes that Applicant’s claimed invention is directed to non-statutory subject matter under 35 U.S.C. § 101. Applicant claims:

**Claim 1:**

*A method for automatically interpreting a non-interactive electronic message, comprising the steps of:*

Art Unit: 2762

- *receiving the electronic message from a source;*  
- *interpreting the electronic message using a rule base and case base knowledge engine; and*  
- *classifying the electronic message as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator.*

According to the broadest reasonable interpretation, the claimed invention is an algorithm for manipulating a data structure containing ***functional descriptive material***, which is ineligible for patent under 35 U.S.C. § 101. *See* MPEP § 2106 (IV)(B)(1) (***Nonstatutory Subject Matter***) (Rev.1, Feb.2000); MPEP § 2106 (IV)(B)(1)(a) (***Functional Descriptive material***); MPEP § 2106 (IV)(B)(2) (***Statutory Subject Matter***) (Rev.1, Feb.2000). *See generally* MPEP § 2106 (***Patentable Subject Matter - Computer-Related Inventions***) (Rev.1, Feb.2000).

The Examiner interprets that “*interpreting a ... message*” is not a practical application. However, the Examiner interprets that the specification does teach means for reducing the number of messages that must be processed by employees thereby saving labor costs, which is a practical application.

**Claims 2-66** are rejected for the same reasons as claim 1.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2762

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. **Claims 1-13, 15-29, 31-66** are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The claimed invention is clearly anticipated by Microsoft's "Microsoft Outlook 97 (Version 8.0)," which was on sale and in public use on June 5, 1995. Applicants claim:

**Claim 1:**

*A method for automatically interpreting a non-interactive electronic message, comprising the steps of:*

- receiving the electronic message from a source;*
- interpreting the electronic message using a rule base and case base knowledge engine; and*
- classifying the electronic message as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator.*

Microsoft teaches various strategies for organizing email, including the use of a **Rules Wizard**.

The **Rules Wizard** explicitly teaches interpreting the message and classifying the message for automated response, including filing in a designated folder, filing a copy in the designated folder, deleting it, forwarding it to another address or addresses, replying to it, or providing user notification. Microsoft further teaches automated processing of emails, such as for gathering opinions and automated processing of the opinions to track the result of the vote.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 2:**

*The method of claim 1, further comprising the step of retrieving one or more predetermined responses from a repository for automatic delivery to the source when the classification step indicates that the electronic message can be responded to automatically.*

Art Unit: 2762

Microsoft **explicitly** teaches the use of a template, from a library of templates, to automatically reply to a message, the equivalent of Applicant's "*further comprising the step of retrieving one or more predetermined responses from a repository for automatic delivery to the source when the classification step indicates that the electronic message can be responded to automatically*" limitation. See *Getting Results*, page 379.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 3:**

*The method of claim 1, further comprising the steps of*  
- *retrieving one or more predetermined responses from a repository, the predetermined responses being proposed for delivery to the source;*  
- *forwarding the electronic message and the predetermined response to the human operator when the classification step indicates that a response to the electronic message requires assistance from a human operator; and*  
- *delivering the predetermined response to- the source when the human operator deems the response appropriate.*

Microsoft **explicitly** teaches the use of a template, from a library of templates, to automatically reply to a message, the equivalent of Applicant's "*retrieving one or more predetermined responses from a repository, the predetermined responses being proposed for delivery to the source*" limitation. See *Getting Results*, page 379.

Microsoft **explicitly** teaches the use of the **Rules Wizard** to automatically forward a message to one or more email addresses, the equivalent of Applicant's "*forwarding the electronic message and the predetermined response to the human operator when the classification step indicates*

Art Unit: 2762

*that a response to the electronic message requires assistance from a human operator” limitation.*

*Id.*

As noted previously, Microsoft **explicitly** teaches the use of the **Rules Wizard** to automatically reply to a message using a template, the equivalent of Applicant’s “*delivering the predetermined response to- the source when the human operator deems the response appropriate*” limitation.

*Id.*

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 4:**

*The method of claim 3, further comprising the step of further categorizing the electronic message into at least one of a plurality of sub-categories based on subject matter content of the electronic message.*

Microsoft teaches the use of “*folders*” for organizing email messages according to the user’s preference. Microsoft **explicitly** teaches the user of the **Rule Wizard** to file the original message, or a copy of the mail message, in designated folders.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 5:**

*The method of claim 4, wherein the sub-categories include product service subject matter and product sales subject matter.*

The Examiner notes that the proposed “*sub-categories*” merely relate a **proposed use** for the invention, not a functional limitation of the invention. As such, the “*sub-categories*” do not



Art Unit: 2762

further distinguish the claimed invention from prior art. Claim 5 is rejected for the same reasons as claim 4.

**Claim 6:**

*The method of claim 4, further comprising the step of prioritizing the sub-categorized electronic message into at least one of a plurality of priorities based on the subject matter content of the electronic message wherein a higher priority indicates that the human operator should process the associated electronic message before processing lower prioritized electronic messages.*

The Examiner notes that *Outlook for Office 97* supports three message priorities: *Low Importance, Normal Importance, and High Importance*, the equivalent of Applicant's "further comprising the step of prioritizing the sub-categorized electronic message into at least one of a plurality of priorities based on the subject matter content of the electronic message wherein a higher priority indicates that the human operator should process the associated electronic message before processing lower prioritized electronic messages" limitation.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 7:**

*The method of claim 6, wherein the plurality of priorities of a product service category include at least one of (i) fraud and lost products; (ii) sensitive information; (iii) general information; and (iv) user comments.*

The Examiner notes that the listed "priorities" merely relate a ***proposed use*** for the invention, not a functional limitation of the invention. As such, the "priorities" do not further distinguish the claimed invention from prior art. Claim 7 is rejected for the same reason as claim 6.

**Claim 8:**

*The method of claim 7, wherein the listed priorities are in order from highest to lowest priority.*

Art Unit: 2762

The Examiner notes that messages may be *sorted* according to priority by clicking the “!” column to select the message priority as the sort index. *See Getting Started*, page 376.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 9:**

*The method of claim 6, wherein the plurality of priorities of a product sales sub-category include promotional content, request for services, and general questions and lengthy messages.*

The Examiner notes that the listed “*priorities*” merely relate a *proposed use* for the invention, not a functional limitation of the invention. As such, the “*priorities*” do not further distinguish the claimed invention from prior art. Claim 9 is rejected for the same reason as claim 6.

**Claim 10:**

*The method of claim 9, wherein the listed priorities are in order from highest to lowest priority.*

The Examiner notes that messages may be *sorted* according to priority by clicking the “!” column to select the message priority as the sort index. *See Getting Started*, page 376.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 11** is rejected for the same reasons as claim 1.

**Claims 12, 13** are rejected for the same reasons as claim 3.

**Claim 15:**

*The method of claim 1, wherein the electronic message is received over an electronic data communications channel.*

Art Unit: 2762

**By definition**, e-mail is transmitted and received over an electronic data communications channel. The limitation is inherent in Microsoft's *Outlook for Windows 97*.

**Claim 15** is rejected for the same reasons as claim 1.

**Claim 16:**

*The method of claim 15, wherein the electronic data communications channel is the Internet.*

Microsoft **explicitly** teaches the use of e-mail on the Internet. *See Getting Started*, page 380.

Microsoft's *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 17:**

*The method of claim 15, wherein the electronic message is an electronic mail (E-mail) [sic] message.*

Microsoft **explicitly** teaches the use of e-mail. *See Getting Started*, page 380. Microsoft's

*Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 18:**

*A method for automatically interpreting an electronic mail (E-mail) message, comprising the steps of.*

- receiving the E-mail from a source over an electronic data communications channel;
- interpreting the E-mail using a rule base and case base knowledge engine; and
- classifying the E-mail as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator; wherein when the classification indicates that the E-mail can be responded to automatically, the method further includes the steps of
  - retrieving one or more predetermined responses from a repository;
  - formulating an E-mail response from the predetermined response; and
  - transmitting the E-mail response to the source over the data communications channel.

Art Unit: 2762

Microsoft teaches the use of a **Rule Wizard** to generate a hierarchy of “rules” the equivalent of Applicant’s “rule base” limitation. Microsoft also teaches the use of folders to hold e-mail messages, the equivalent of Applicant’s “case base” limitation.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claims 19-21** are rejected for the same reasons as claim 3.

**Claim 22:**

*The method of claim 21, wherein the step of interpreting the electronic message further includes the steps of*

- producing a case model of the electronic message including a set of predetermined attributes for identifying specific features of the electronic message;*
- detecting at least one of text, combinations of text, and patterns of text of the electronic message using character matching;*
- flagging the attributes of the case model which are detected in the electronic message; and*
- classifying the electronic-message as at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator, the classification being performed in accordance with the flagged attributes.*

The Examiner interprets that the claimed invention parses incoming messages for comparison against the message-processing rules in the rule base. The Examiner interprets that the cited limitations are necessarily inherent features of Microsoft’s *Outlook for Office 97* which are required for enablement.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claims 23-30** are rejected for the same reasons as claim 22.

**Claim 31:**

*A system for automatically interpreting a non-interactive electronic message received from a source, the system comprising:*

Art Unit: 2762

- a server for transmitting and receiving electronic messages over a communications channel;
- an inbox storage device for storing incoming electronic messages;
- a knowledge engine including a rule base and a case base, the case base having a plurality of stored cases representing past received electronic messages;
- a pre-processor for receiving the electronic message and interpreting the electronic message using the rule base;
- a searching device for searching the electronic message and the case base to retrieve a stored case from the case base which most closely matches the electronic message;
- a classifier for classifying the electronic message into at least one of (i) being able to be responded to automatically; and (ii) requiring assistance from a human operator.

The Examiner notes the introduction of the “*inbox*” limitation. Microsoft teaches the use of an “*inbox*” the equivalent of Applicant’s “*inbox*” limitation. All other limitations have already been addressed in this office action.

Microsoft’s *Outlook for Office 97* clearly anticipates the claimed invention.

**Claim 32-40** are rejected for the same reasons as claim 31.

**Claims 41-48** are rejected for the same reasons as claim 3.

**Claims 49-53** are rejected for the same reasons as claim 22.

**Claim 59:**

*The method of claim 1, wherein the electronic message includes fixed data.*

The Examiner notes that e-mail messages *inherently* include fixed data, such as header fields.

**Claim 59** is rejected for the same reasons as claim 1.

**Claim 60:**

*The method of claim 1, wherein the electronic message includes variable data.*

Art Unit: 2762

The Examiner notes that e-mail messages *inherently* include variable data, such as a “from” field, “to” field, “subject” field and message body. **Claim 60** is rejected for the same reasons as claim 1.

**Claim 61** is rejected for the same reasons as claim 3.

**Claim 62** is rejected for the same reasons as claim 59.

**Claim 63** is rejected for the same reasons as claim 60.

**Claim 64** is rejected for the same reasons as claim 3.

**Claim 65** is rejected for the same reasons as claim 59.

**Claim 66** is rejected for the same reasons as claim 60.

***Examiner's Comment***

10. With respect to the rejection under 35 U.S.C. § 101, the Examiner understands that the present invention might have practical application by minimizing the number of employee manhours required to process electronic message traffic. However, an examiner is prohibited from reading limitations present in the specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2762

*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Pender whose telephone number is (703) 308-0147. The Examiner can normally be reached on Monday - Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Tariq Hafiz can be reached at (703) 305-9643. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry), or:

(703) 308-1396, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).



Michael Pender

July 10, 2000

